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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,532	01/10/2001	Geoffrey B. Rhoads	60244	9755
23735	7590	06/06/2005	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			NGUYEN, SIMON	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/758,532	RHOADS, GEOFFREY B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SIMON D NGUYEN	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 06 December 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 2 and 7-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 2 and 7-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 21 June 2004 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: .

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 2, 7-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,278,781 in view of claims 1-32 of U.S Publication No. 2005/0058319 A1.

Regarding independent claims 2, 7, and 17, patent "781" discloses a wireless device including a mic, a modulator, an encoder for encoding steganographically, and an RF amplifier for transmitting the RF signal, (claim 1), and the device further includes a receiver having a decoder for steganographically decoding (claims 6, 9), a processor for decoding steganographically (claim 7), a display (claim 8). However, patent "781" fails to teach an optical sensor for producing images.

The US application no. "319" discloses a portable device having a sensor to capture image and a decoder for watermarkedly (steganographically) decoding the

image (claims 14, 29, 24). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to employ a decoder for steganographically decoding images in a wireless device in order to improve audio or image signals.

Regarding dependent claims 8, 16, 18-20, these limitations have been disclosed in claims 1-9 of patent "781" or claims 1-32 of US application no. "319" or these limitations are known in the art.

In conclusion, the double patenting rejection under the US patent "781" and the US application no. "319" is reasonable.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 2, 7-20 have been considered but are moot in view of the new ground(s) of rejection.

a) The limitations of independent claims 2, 7, 17 have been taught or disclosed by claims 1-9 of patent "781" and claims 1-32 of US application number "319" as stated in the double patenting above, which the examiner believes that it is reasonable for the double patenting rejection.

b) Even though, the examiner dropped the double patenting rejection under claims 1-9 of patent no. "781" in view of Reele et al. (5,893,037). The examiner still believe that it is obviously for those skilled in the art to reject the double patenting of claims 2, 7-20 under patent no. 781 and Reele. Since the patent no. "781" discloses a wireless telephony device having a transceiver including a mic, demodulator, modulator, display, processor, decoder, encoder. What missing in "781" is a camera for taking a

picture, which is support by Reele. The applicant should note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

c) It is also reminded the applicant that under Article 35 U.S.C. 134. the Appeal Brief to be filed only after the second rejection to be issued, not one like this Appeal Brief (first time rejection, an election/rejection does not count as a rejection).

*35 U.S.C. 134. Appeal to the Board of Patent Appeals and Interferences.*

(a) PATENT APPLICANT. — An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

d) It is also reminded the applicant that if the applicant want to submit an Appeal Brief, the Appeal Brief should file based on the newest rejection (the double patenting rejection under patent no. "781" and the US application no. "319), not like this Appeal Brief, which based on the first Office Action (the rejection under Reele et al. and Ray (6,192,257).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (571) 272-7894. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (571) 272-7899.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
600 Dulany, Alexandria, VA 22314

Or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Hand-delivered response should be brought to Knox building,  
501 Dulany, Alexandria, VA.

Simon Nguyen

May 27, 2005

**SIMON NGUYEN  
PRIMARY EXAMINER**

